

REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the claims in the present Application:

CLAIM	STATUS	DEPENDENCY
1.	Currently Amended	Independent
2.	Original	1
3.	Original	2
4.	Original	3
5.	Original	1
6.	Original	1
7.	Original	6
8.	Currently Amended	1
9.	Original	1
10.	Original	9
11.	Currently Amended	1
12.	Original	1
13.	Original	12

Comments of Examiner James T. NELSON have been reviewed carefully with pertinent sections of the Patent Act, Patent Rules, the Manual of Patent Examining Procedure, legal treatise and relevant decisional law. The Application has been amended in accordance with

Examiner NELSON's requirements and allowance of the Application, as amended, is solicited earnestly.

Claims 1, 8 and 11 have been rejected under 35 USC 112, second paragraph as being indefinite.

According Claims 1, 8 and 11 have been amended and Claims 1, 8 and 11 as amended are believed to be patentable. No new matter has been added.

Claims 1, 2, 6, 7 and 9 have been rejected under 35 USC 103(a) as being unpatentable over Gigante (US Patent No. 3,490,822).

Claim 3 has been rejected under 35 USC 103(a) as being unpatentable over Gigante (US Patent No. 3,490,822) in view of the French document (FR 1,143,195-A).

Claim 4 has been rejected under 35 USC 103(a) as being unpatentable over Gigante (US Patent No. 3,490,822) in view of the French document (FR 1,143,195-A), as applied to Claim 3 and further in view of Brooks (US Patent 1,643,738).

Claim 5 has been rejected under 35 USC 103(a) as being unpatentable over Gigante (US Patent No. 3,490,822), as applied to Claim 1, in view of Korinsky (US Patent No. 5,419,629).

Claim 10 has been rejected under 35 USC 103(a) as being unpatentable over Gigante (US Patent No. 3,490,822), as applied to Claim 9, in view of Stuart (US Patent No. 6,119,992).

Claim 11 has been rejected under 35 USC 103(a) as being unpatentable over Gigante (US Patent No. 3,490,822), as applied to Claim 1, in view of DeWilde (US Patent No. 3,834,325).

Claims 12 and 13 have been rejected under 35 USC 103 (a) as being unpatentable over Gigante (US Patent No. 3,490,822), as applied to Claim 1, in view of Mader (US Patent No. 2,850,171).

Reconsideration of the Examiners rejection of Claims 1-7 and 9-13 is requested on the following differences between the structure shown thereon, the structure of the present invention and the statements of the Examiner.

1. Gigante does not show a TV rack as in the present invention but rather a closed cabinet. The combination of the metal frame bars, the wooden back, bottom and top panels and the partition boards as claimed in Claim 1 is not shown in Gigante nor is this combination shown in any of the cited references.

2. The Gigante device is directed to providing furniture which does not rely on fasteners but rather on slotted interlocking members.

3. The present invention does not rely on slotted interlocking members as in Gigante but utilizes frames which are connected to a panel e.g. panel 60 using fasteners 61. The wooden open frame fixed to the elongated top horizontal frame of Claim 1 is not shown in Gigante nor in any the cited references.

4. The Examiner states that Gigante in Fig. 2 shows “at least one horizontal mounting lug 11 at free ends of frame portions 6.” Examination of Fig. 2 shows that the frame portion 6 do not have free ends and that Fig. 2 does not show lugs 11 of any kind. Ref. no. 11 does not appear in Gigante Fig. 2 but rather in the Examiner’s version of Fig. 2 of Gigante.

5. Item 11 of Gigante is not a lug but rather a U-shaped clamp (See Col. 5 Line 40) which fits into channels 1F and are not retained by fasteners. Item 11 is of extended length and does not resemble the lugs of the present invention.

6. The present invention does not use U-shaped clamps of extended length. The lugs of present invention do not fit into channels and are retained by fasteners 14.

7. Regarding Claim 9 the Examiner states that “Gigante shows partition board holders (13) comprising U-shaped clamps (13) fixedly fastened the back panel (9) by fastening elements (13). The element 13 of Gigante clearly can not be both a U-shaped clamp (13) and a fastening element (13). Examination of Gigante shows that element 13 is a bar with a slot (Col. 4, Line 22). The element 13 which is a bar has no structural or relationship to the U-shaped clamp of the present invention.

8. Examination of the French document shows that the French document shows a pair of panels labeled 1 and 2 with a notch in each panel. The present invention teaches and claims a single back panel with a single notch. There is no structural relationship between the device shown in the French document and the structure of the present invention.

9. There is no relationship between the structure of the display case of Brook and the structure of the present invention. There are no panels in the present invention which resemble the panel of Brook.

10. Korinsky shows a Electrical Chassis and method of manufacture which has no relationship to the TV rack of the present invention. Korinsky shows a closed metal box-like cabinet which does not resemble nor lead to the teaching of the present invention. In Stuart the C-clamp attaches a lamp to a shelf. In the present invention a board is supported by a clamp as claimed in Claim 9.

11. Stuart shows a C-clamp type of structure with a ratchet latch and a projecting member for attachment (4d) of a lamp to a shelf. There is no structure in Stuart which facilitates the support of a shelf as in the present invention.

12. DeWilde shows a table which has no relationship to the TV rack of the present invention.

13. Mader shows a shelf-type display rack which has a vertical member which supports a plurality of open shelves. There is no relationship between this structure and the TV rack of the present invention.

There is no teaching in the Gigante, French document 1,143,195-A, Brooks, Korinsky, Stuart, DeWilde and Mader references alone or in combination which leads to the structure of the present invention.

For the above reasons the application of the Gigante, French document, Brooks, Korinsky, Stuart, DeWilde and Mader references is not considered to be appropriate.

In a famous footnote in *Hodosh v. Block Drug Co.*, 786 F.2d 1136, 229 USPQ 182, 1897 (Fed. Cir., 1986), the Federal Circuit set out five principles, with citations to previous cases, regarding obviousness determination under Section 103. The footnote (as to the first four principles reads as follows:

Our comments on the district court's obviousness determination generally include the following tenets of patent law that must be adhered to when applying § 103;

(1) the claimed invention must be considered as a whole (35 USC 103); see, e.g. *Jones v. Harty*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir., 1984) (though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

(2) the references must be considered as whole and suggest the desirability and thus the obviousness of making the

combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 220 USPQ 481, 488 (Fed. Cir. 1984);

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g. *W.I. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));

(4) “ought to be tried” is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220 USPQ at 1026.

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues hereininvolved.

It is submitted that the Examiner’s position in applying Gigante, French document 1,143,195-A, Brooks, Korinsky, Stuart, DeWilde and Mader is contrary to the above quoted tenets of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as whole, it is self-evident that Applicant’s invention is not rendered obvious by the cited prior art, whether considered alone or in combination.

The statutory presumption of 35 USC § 282 makes an invention presumptively non-obvious unless the Examiner can demonstrate the “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains,” 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of the ordinary skill when the invention was made; and (4) any other objective considerations including evidence of commercial success, copying, and a long-felt need in the industry. *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1270, 1273 (Fed. Cir. 1991) (citing *Graham v. Deere Co.*, 383 US 1.17 (1966)). The decision maker is not to apply hindsight, but must analyze obviousness from the viewpoint of a person skilled in the art prior to the disclosure of the present invention *Panduit Corp. v. Dennis Mfg. Co.*, 810 F2d 1561, 1566 (Fed. Cir.), *cert denied*, 481 US 1052 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely “icing on the cake.” *Hybrietch, Inc. v. Monoclonal Antibodies, Inc.*, 802 F2d 12367, 1380 (Fed. Cir. 1986), *cert.denied*, 4580 US 947 (1987). The Federal Circuit has stated that:

(I)ndeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant’s invention from selecting bits and pieces from Gigante, French document 1,143,195-A, Brooks, Korinsky, Stuart, DeWilde and Mader. The cherry picking exercise is just the sort of hindsight reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggests to a person or ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. *Panduit Corp.* 810 F2d at 1568. The prior art existed for many years and yet those skilled in the

art never created a TV rack comparable to Applicant's. See id. at 1577 (that skilled workers did not create (patented) invention, despite existence of elements in the prior art, is evidence of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weigh strongly in favor of conclusion that Applicant's invention is not obvious. *Continental Can*, 948 F2d at 1273.

The status of the Claims is as follows

Claims 1-8 and 11 have been amended.

Claims 2-7, 9-10 and 12-13 are original .

It is believed that Claims 1-13 are patentable.

In view of the foregoing submissions and explanations, it is believed that Claims 1-13 are in condition for allowance. An early Notice of Allowance on the Application will be appreciated.

Courtesy, cooperation and skill of Examiner James T. NELSON are appreciated and acknowledged.

Date: New York, New York
November 22, 2005

Respectfully,

HART, BAXLEY, DANIELS & HOLTON

By: Charles E. Baxley
Charles E. Baxley
Attorney of Record
USPTO Reg. 20,149
90 John Street, Third Floor
New York, New York 10038
Tel: (212) 791-7200
Fax: (212) 791-7276
E-mail: ceb@hartbaxley.com

CEB:rmm/13880 B

Enclosure: Replacement Sheet Annotated sheet showing changes.

AMENDMENTS TO THE DRAWINGS

The attached sheet of drawings includes changes to Fig. 2. This sheet which includes Fig. 2 replaces the original sheet including Fig. 2. In Fig. 2 previously omitted references numeral 32 has been added.



APPLICATION NO. 10/637,929
AMENDMENT DATED NOV 21, 2005
REPLY TO OFFICE ACTION OF AUG 23, 2005
ANNOTATED SHEET SHOWING CHANGES

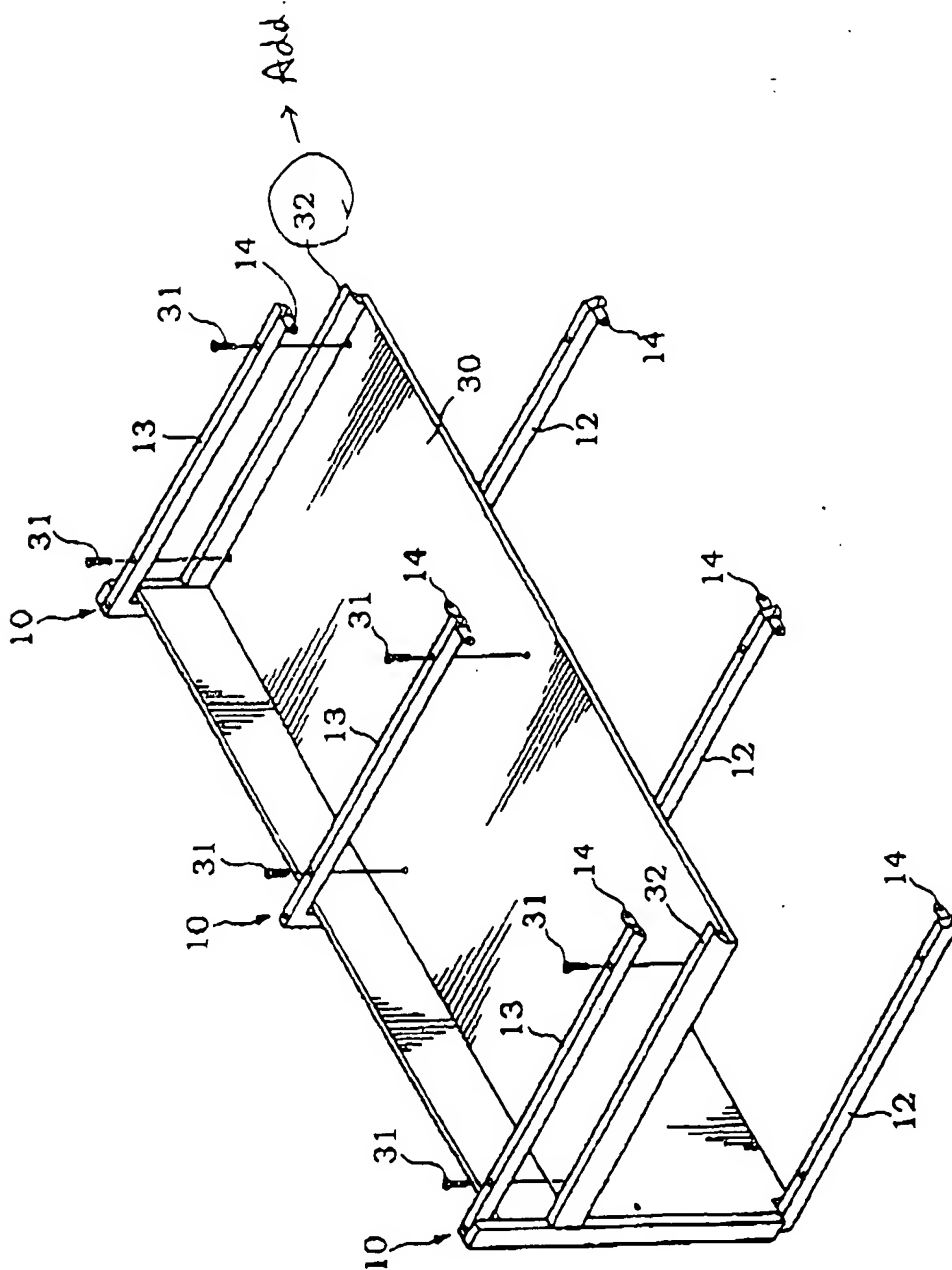


FIG. 2